

REMARKS

Claims 16-35 are pending in the present application. Claims 16, 23 and 29 are amended. No new matter is involved. Claims 16, 23 and 29 are independent claims.

Amended Claims

Amended independent claims 16, 23 and 29 recite a combination of features, including a feature of receiving a plurality of icons from a plurality of broadcast stations, where each of the icons represents and facilitates identification of a particular selected broadcast station. An icon of a broadcast station associated with a user's selection of a particular channel that facilitates identification of the selected channel can be displayed during a time gap in digital television channel switching. Basis for this feature is found in Applicant's originally filed disclosure, for example, in the last paragraph on page 7.

Rejections under 35 USC §103

Claims 16-35 stand rejected under 35 USC §103(a) as unpatentable over U.S. Patent 5,786,845 to Tsuria in view of U.S. Patent 5,907,321 to Grossman. This rejection is respectfully traversed.

During patent examination the PTO bears the initial burden of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443,

1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a prima facie case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability vel non is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

As is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

In rejecting claims under 35 USC 103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive

at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish prima facie obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d

1225, 1232(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Tsuria is directed to providing messages in the form of “advertisements” which are disclosed as “preferably in the form of slides accompanied by voice data.” – see col. 3, lines 54-57, for example.

Tsuria contains no disclosure or suggestion of (1) providing icons, as recited; or (2) providing an icon on the screen during a time gap in digital television channel switching to facilitate identification of the selected channel, as recited.

The Office Action, apparently realizing the shortcomings of Tsuria, turns to Grossman to combine with Tsuria.

Grossman is directed to providing advertising information or commercial value, such as a corporate logo, trademark or text message, or a public service nature – see col. 3, lines 35-45, for example. In the preferred embodiment, the advertisement is sent from the cable headend to be displayed on the TV set – see col. 3, lines 53-55, for example.

Grossman contains no disclosure or suggestion of providing an icon on the screen during a time gap in digital television channel switching to facilitate identification of the selected channel, as recited.

Neither Tsuria nor Grossman is directed to facilitating identification of a selected channel, as is the claimed invention.

As neither applied reference even suggests providing an icon on the screen during a time gap in digital television channel switching to facilitate identification of the selected channel, the basis for providing an icon on the screen during a time gap in digital television channel switching to facilitate identification of the selected channel must be speculation and/or impermissible hindsight based solely on Applicant's disclosure, both of which are improper grounds for rejecting claims under 35 USC §103(a).

Accordingly, the Office Action has not made out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of pending claims 16-35 is respectfully requested.

CONCLUSION

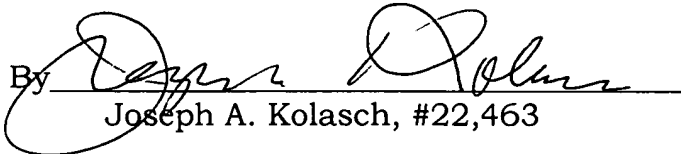
In view of the above comments, all of the pending claims are allowable over the prior art of record, and an early issuance of a Notice of Allowance is respectfully requested.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster, Registration No. 46,472, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Joseph A. Kolasch, #22,463

P. O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

JAK/RJW:kss/gf 